

REMARKS

The office action and the patents that were cited and applied have been carefully considered together with the present application and amendments have been made to the independent claims 1 and 10 to more clearly define the present invention and to further emphasize pre-existing differences between the present invention and the prior art that has been cited and applied by the examiner.

The examiner has now rejected claims 1-12 under § 112, second paragraph, as being indefinite. With regard to claim 1, the examiner continues to object to the use of the phrase “of the type” because it is stated to be unclear as to what “type” of rotary hand tool the applicant is intended to convey. While applicant respectfully disagrees with this rejection as previously indicated in Amendment A, applicant has reluctantly deleted this phrase from claims 1 and 10. Applicant unequivocally states that this amendment is not remotely believed to be related to patentability, but is related to the examiner’s unreasonable elevation of form over substance.

The examiner has now rejected claims 1 and 3-5, 10 and 12 under 35 U.S.C. § 102 as being anticipated by Sjostrom and has also rejected claim 2 under 35 U.S.C. § 103 as being obvious over Sjostrom in view of Markle. The examiner has also rejected claims 6-9 and 11 under 35 U.S.C. § 103 as being obvious over Sjostrom in view of Von Hollen.

As a result of the amendments that have been made to independent claims 1 and 10, it is believed that neither of these claims are anticipated, taught or suggested by Sjostrom applied singularly or in combination with either Markle or Von Hollen.

The examiner now relies upon the new Sjostrom patent to reject the claims either as being anticipated or obvious. It is strongly believed that Sjostrom totally fails to anticipate, teach or suggest these claims because it is substantially unrelated art and it is concerned with surgical devices. It is an extremely complex sophisticated system that is used for arthroscopic surgery. It has a number of switches 125, 130 and 135 which have multiple functions that are operational as a result of their interaction with a separately located processor 215 that is connected to the switches of the surgical device through a cable 145. The switches are magnetic switches that utilize Hall effect devices as well as a host of other technologically advanced elements which are combined to enable the surgical device to operate. Much of the design and technology is necessary so that the device can be autoclaved which requires extremely high temperatures.

The Sjostrom surgical device has nothing to do with what is claimed in claims 1 and 10 as well as in the dependent claims that relate to these independent claims. Applicant has made amendments to claims 1 and 10 in an effort to distinguish over Sjostrom. More particularly, claim 1 has been amended to define a control mechanism for a rotary hand tool . . . , said control mechanism being a part of the tool and located substantially within the housing thereof and comprising the elements of an electrical control circuit as defined in the claim, and a light touch switch as defined in the claim.

Claim 10 is directed to an apparatus for selectively controlling power applied to the operation of the motor of a rotary hand tool . . . , said apparatus comprising electrical control circuitry for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located substantially

within the housing, as well as a switch as described, wherein said switch is stated to be a part of the tool and located substantially within the housing thereof, in addition to a cavity as defined in the claim.

Sjostrom does not meet the language of these claims for the reason that it includes different sections of the overall system that are physically separated from one another. It has the device 200 which does not include the microprocessor 215 because the latter is part of a separate console, not to mention that there is a separate foot control 210 that is operably connected to the console. Applicant's claims 1 and 10 are directed to a control mechanism and apparatus, respectively, which are totally self-contained as is evident from the language of these claims. There is no doubt whatsoever that Sjostrom's sophisticated system includes a separate console as well as a separate foot control in addition to the surgical device.

With respect to the obviousness rejections, applicant believes that they are improper. There is no motivation for any combination of Sjostrom with either Markle or van Hollen. Sjostrom is unrelated art and is not properly combinable with either of these references. Moreover, there is no motivation supplied by any of these three references to combine them with the other. It defies common sense that such a combination would be made which is contrary to the recent decision of *In re Kahn* from the Court of Appeals for the Federal Circuit. Reconsideration and allowance of independent claims 1 and 10 is respectfully requested.

The dependent claims necessarily incorporate the subject matter of the independent claims from which they depend and in addition add other features and/or

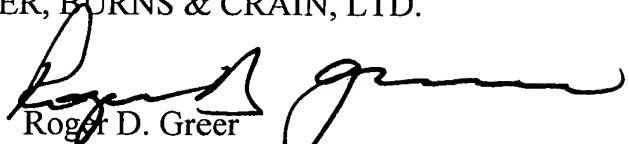
functionality that are not found in the independent claims and for this reason the dependent claims are also believed to be in condition for immediate allowance.

Reconsideration and allowance of all claims presenting pending in the application is therefore respectfully requested.

Respectfully submitted,

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